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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,710	11/28/2000	John Thomas Amend	47692-00003USPT	7699

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EXAMINER

BASHORE, ALAIN L

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/724,710

Applicant(s)

AMEND ET AL.

Examiner

Alain L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-124 is/are pending in the application.
- 4a) Of the above claim(s) 120-124 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-119 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-119 drawn to: a system and method of linking real estate with tenants; medium having data structure for compiling real estate demand; method of determining potential interest in meeting a real estate need; method for facilitating real estate acquisition and outfitting, and a method of automating lease administration; all classified in class 705, subclass 37.
  - II. Claims 120-124 drawn to method of facilitating on-line real estate agreement formation classified in class 705, subclass 35.
2. Inventions of groups I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group II has separate utility such as for non-tenant real estate. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Ms. Rudnick on 6-4-02 a provisional election was made without traverse to prosecute the invention of group I, claims 1-119. Affirmation of this election must be made by applicant in replying to this Office action. Claims 120-124 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Information Disclosure Statement***

5. The information disclosure statement (IDS) filed on 1-24-02 does not fully comply with the requirements of 37 CFR 1.98 because: no date is given for the Rich article under "other documents". Since the submission appears to be *bona fide*, applicant is given **ONE (1) MONTH** from the date of this notice to supply the above mentioned omissions or corrections on a corrected information disclosure statement. The corrected information disclosure statement will be included with the next office action. NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b).

A copy of the IDS is included with this office action where the examiner has crossed through the documents with incomplete citations.

Failure to timely comply with this notice will result in the any revised information disclosure statement as having to comply with the rules at the time of re-submission. Applicant is advised that in such an event the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining

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compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### ***Drawings***

6. Figures 1-4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. It is noted that applicant uses the term "conventional" in describing figures 2-4. If figures 1-4 are not prior art, applicant must clearly state on the record that what is shown is not prior art.

See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 14-15, 18, 26-29, 48-49, 58-61, 71, 76, and 78, 87, 93 and 103 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following are considered indefinite:

Claim 1: “paradigm”, “ad hoc”, “empower”;

Claim 14, 15, 48 and 49: “qualified”;

Claim 18 and 103: “interest”, “interests”, interesting”.

Claim 1, line 13, “the at least one tenant” appears to lack antecedent basis.

Claims 26-29 and 58-61: recite an “entry” but it is not clear if this refers to a method limitation or an apparatus limitation. The term “entry” is considered indefinite.

Claims 71, 76, and 78: appear to be improper Markush claims because of the use of open language “...from the group ...comprising...”.

Claim 80, the recitation “the real estate outfitting process” lacks antecedent basis.

Claims 87: “another phase” is indefinite and lacks antecedent basis since the generic term “phase” is not defined.

Claim 93: the use of alternatives in the recitation “bidding/estimation/value/engineering” appears to be confusing when used in the same recitation of a listing starting with “at least one of the following ...”.

***Claim Rejections - 35 USC § 102 and 35 USC § 103***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-7, 26-29, and 114-119 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al.

Good et al discloses a network (12) and real estate facilitator (13) connected to the network. The real estate facilitator is capable of communicating with the at least one prospective tenant and a plurality of landlords (col 4, lines 21-26, 36-41). The prospective tenant submits information specifying desired real estate (col 5, lines 63-67; col 6, lines 1-26). The facilitator includes a real estate supply database (col 4, lines 27-30). The facilitator allows at least one prospective tenant to select a piece of real estate in which the collection is formed responsive to the at least one desired characteristic of real estate. Good et al discloses virtual reality tours (col 3, lines 20-24) and actual visits to sites (col 3, line 37). The system and method to Good et al is real estate acquisition (finding a rental property) and outfitting (providing analysis), and the phases disclosed include: a real estate phase and an analysis phase.

With regards to a “paradigm” it is the examiner’s position that such would have been obvious to one with ordinary skill in the art in include to Good et al since Good et al teaches that landlords must find new ways to attract renters (col 2, lines 35-39).

Regarding claims 26-29 there is presented device claims (storage medium) where there appears to be no further physical description recited. There is disclosed a storage medium.

Good et al does not disclose a real estate demand database, a building database, notifying an entity corresponding to a second phase of real estate outfitting of a change to information related to real estate, or over-lapping phases.

Keithley et al discloses a real estate demand database (col 6, lines 43-49), a building database (col 6, lines 30-40), and notifying an entity corresponding to a second phase of real estate outfitting of a change to information related to real estate including over lapping phases (col 2, lines 10-23; col 6, lines 62-67)).

It would have been obvious to one with ordinary skill in the art to include a building database and demand database to Good et al because Keithley et al teaches rental property information demand (col 1, lines 49-51).

It would have been obvious to one with ordinary skill in the art to include to Good et al notifying an entity corresponding to a second phase of real estate outfitting of a change to information related to real estate including over lapping phases because



Keithley et al teaches other phases as an outgrowth of real estate demands (col 11, lines 47-66).

13. Claims 8-25, and 30-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Keithley et al as applied to claims 1-7, 26-28 above, and further in view of Walker et al.

Good et al in view of Keithley et al does not explicitly disclose proposal requests where the requests are sent to landlords, or proposals returned from landlords for further consideration by prospective tenants.

Walker et al discloses proposal requests (CPOs) that are returned for further consideration. It would have been obvious to one with ordinary skill in the art to include to Good et al in view of Keithley et al proposal requests where the requests are sent to landlords and proposals returned from landlords for further consideration by prospective tenants because of what is taught by Walker et al. Walker et al teaches a buyer-driven system where the buyer dictates the terms of the offer (col 1, lines 23-34) and Good et al teaches a buyer driven rental market (col 2, lines 40-55).

Regarding claims 58-61 there is presented device claims (storage medium) where there appears to be no further physical description recited. There is disclosed a storage medium.

15. Claim 97 is rejected under 35 U.S.C. 102(e) as being anticipated by Shirley et al.

Shirley discloses a method for facilitating real estate transactions (col 19, lines 25-29), comprising the steps of: uploading, by a first party, a file, the file including information relating to a potential real estate transaction; accessing, by a second party, the file; changing, by the second party, the file; uploading, by the second party, the changed file; and wherein at least one of the first party and a third party may access the changed file (col 2, lines 8-61; fig 8).

16. Claims 98-99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirley et al in view of Keithley et al.

Shirley et al does not disclose information relating to a potential real estate transaction, or where the second party comprises at least one of a designer, an architect or an engineer.

Keithley et al discloses information relating to a potential real estate transaction (col 6, lines 30-50), and a second party comprises at least one of a designer, an architect or an engineer (col 6, lines 60-67).

It would have been obvious to one with ordinary skill in the art to include transaction information and a second party to Shirley because Shirley et al teaches contract formation of different parties (col 2, lines 8-23).

17. Claims 100-107, are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al in view of Walker.

Good discloses a prospective tenant: reviewing a list of real estate, selecting real estate that meets at least one preliminary criterion.

Good does not disclose RFIs where the requests are sent to landlords, or responses returned from landlords for further consideration by prospective tenants.

Walker et al discloses requests (CPOs) that are returned for further consideration. It would have been obvious to one with ordinary skill in the art to include to Good et al RFIs where the requests are sent to landlords and resp[onses returned from landlords for further consideration by prospective tenants because of what is taught by Walker et al. Walker et al teaches a buyer-driven system where the buyer dictates the terms of the offer (col 1, lines 23-34) and Good et al teaches a buyer driven rental market (col 2, lines 40-55).

18. Claims 108-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weatherly et al. in view of Shirley et al

Weatherly et al discloses monitoring a lease to detect an upcoming expiration, and triggering a lease handling routine if an upcoming expiration is detected (col 3, lines 3-65).

Weatherly et al does not disclose accumulating a plurality of contracts into a database.

Shirley et al discloses accumulating a plurality of contracts into a database (104).

It would have been obvious to one with ordinary skill in the art to include accumulating a plurality off contracts into a dadatabase to Weathely et al because Shirley et al discloses contract revision.

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lange, Bisdikian et al, Isherwood disclose real estate transactions. Silverman et al discloses a matching system, and Ivanov disclose a review system.


19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:30 am to 5:00 pm (Alternate Fridays Off).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1113.

  
Alain L. Bashore  
July 25, 2002

  
VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
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